

Notice of Allowability

Application No.

09/869,709

Examiner

Zachariah Lucas

Applicant(s)

SIPPEL ET AL.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment of July 14, 2005.
2. ☒ The allowed claim(s) is/are 1,24,28-36,39-44,47,60,76-78 and 80-83.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 8/30-05
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Richard M. Lebovitz on August 30, 2005.

The application has been amended as follows:

Claims 37, 38, 45, 46, 48-59, 61-73, and 79 are cancelled from the application.

Claim 42 is amended to read as follows:

- - Claim 42 A screening method for testing the suitability of a plurality of test substances as ligands for a ligand-binding domain of a receptor, characterized in that the assay method of claim 35 is employed for the screening. - -

Claims 37, 38, 45, 46, 48-59, and 61-73 are drawn to non-elected inventions, and are cancelled such that the elected claims may be allowed.

Claim 79 is cancelled as redundant to claim 1.

Claim 42 is amended to clarify that the method of claim 42 differs from the method of claim 35 in that a plurality of test substances, rather than a single test substance, is being tested in the claimed method.

Status of the Claims

2. Currently, claims 1, and 24, and 28-73, and 76-83 are pending in the application. In the prior action, mailed on November 30, 2004, claims 1, 24, and 26-83 were pending, with claims 1, 24, 26-36, 39-44, 47, 60, and 74-83 under consideration and rejected; and claims 37, 38, 45, 46, 48-59, and 61-73 withdrawn from examination. In the Response of July 14, 2005, the Applicant amended claims 1, 60, and 82; and cancelled claims 26, 27, 74, and 75.
3. Claims 37, 38, 45, 46, 48-59, 61-73, and 79 have been cancelled from the application.
4. Claims 1, 24, 28-36, 39-44, 47, 60, 76-78, and 80-83 are allowed.

Specification

5. **(Prior Objection- Withdrawn)** In the prior action, the specification was objected for lacking a Brief Description of the Figures. In view of the amendment of the application, the objection is withdrawn.

Claim Rejections - 35 USC § 101

6. **(Prior Rejection- Withdrawn)** Claims 1, 24, 26, 27, 30-34, 60, 74-83 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because they include embodiments wherein the cell is part of, or inside of a human being. In view of the amendment of the claims to read on "isolated transformed yeast" cells, the rejection is withdrawn.

Claim Rejections - 35 USC § 112

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7. **(Prior Rejection- Withdrawn)** Claim 60 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of the amendment of the claim, the rejection is withdrawn.

8. **(Prior Rejection- Withdrawn)** Claim 79 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite because it is unclear how the scope of the cells of claim 79 is different from the scope of cells in claim 1. In view of the cancellation of the claim, the rejection is withdrawn.

Claim Rejections - 35 USC § 103

9. **(Prior Rejection- Withdrawn)** Claims 1, 24, 26, 27, 30-33, 35, 36, 39-44, 47, 60, 74, 75, and 77-81 were rejected under 35 U.S.C. 103(a) as being unpatentable over Trueheart (U.S. Patent 6,159,705), in view of Ostanin et al. (U.S. Patent 6,251,605), Isakoff et al. (EMBO J 17(18): 5374-87), and Aronheim (Nuc Acids Res 25(16): 3373-74), and further in view of Li et al. (J Biol Chem 272(16): 10337-10340) and Suen et al. (Molec Cell Biol 13:5500-12). In view of Applicant's arguments in traversal, the rejection is withdrawn.

10. **(Prior Rejection- Withdrawn)** Claim 34 was rejected in the prior action under 35 U.S.C. 103(a) as obvious over Trueheart, Ostanin, Isakoff, Aronheim, Li, and Suen, further in view of Mitsuzawa and DeClue. In view of Applicant's arguments in traversal, the rejection is withdrawn.

11. **(Prior Rejection- Withdrawn)** Claims 28 and 29 were rejected under 35 U.S.C. 103(a) as obvious over Trueheart in view of Ostanin, Isakoff, Aronheim, Li, and Suen, further in view

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Ashby, Fink, and the Applicant's admissions in the specification. In view of Applicant's arguments in traversal, the rejection is withdrawn.

12. **(Prior Rejection- Withdrawn)** Claim 76 was rejected under 35 U.S.C. 103(a) as being unpatentable over Trueheart in view of Ostanin, Isakoff, Aronheim, Li, and Suen, further in view of Delorme. In view of Applicant's arguments in traversal, the rejection is withdrawn.

13. **(Prior Rejection- Withdrawn)** Claims 82 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over the teachings of Trueheart, Ostanin, Isakoff, Aronheim, Li, and Suen as applied above, and further in view of the teachings of Hart et al. (Oncogene 14: 945-53). In view of Applicant's arguments in traversal, the rejection is withdrawn.

Conclusion

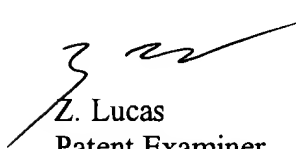
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 571-272-0905. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

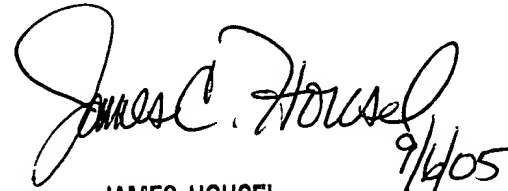
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Z. Lucas
Patent Examiner



JAMES HOUSEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800

9/14/05